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Examiner : Faye Francis
Serial No. : 09/844,322
Filed : April 26, 2001 Docket No.: 1391-CON-00
Inventors : Casey William Norman
: Torquil Patrick Alexander Norman Confirmation No.: 1969
Title : DOLL'S CLOTHING

Dated: June 26, 2006

APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
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Sir:

The Appellants have appealed from the rejection of Claims 20-23, 25, 26 and 28-51. The Appellants submit this Appeal Brief in response to the Official Action dated March 28, 2006, which reopened prosecution after submission of the Appellants' first Brief. A check in the amount of \$500.00 under 41 CFR §41.20(b)(2) was submitted with the Appellants' January 4, 2006 Brief. The Appellants respectfully submit that the earlier fee is applicable to this Brief.

REAL PARTY IN INTEREST

The real party in interest, by Assignment recorded in the USPTO records at Reel 011875 and Frame 0201 is Genie Toys, PLC, a corporation of the United Kingdom located at 25 Imperial Square, Cheltenham, Gloucestershire GL50 1QZ, United Kingdom.

RELATED APPEALS AND INTERFERENCES

The Appellants filed a Notice of Appeal on July 1, 2005 for U.S. Patent Application Serial No. 09/711,194 filed on November 13, 2000 (Attorney Docket No. 1391-CIP-00). An Official Action dated March 4, 2006 reopened prosecution in that application. The Appeal is being reinstated in that application.

STATUS OF THE CLAIMS

The Appellants' Claims 1-19, 24 and 27 were canceled without prejudice and without disclaimer of the subject matter thereof. Claims 20-23, 25, 26 and 28-51 are rejected and on appeal. Claims 21, 22, 33, 38 and 47 are independent claims.

STATUS OF THE AMENDMENTS

The following Amendments and Responses are of record: an Amendment filed December 7, 2001 in response to the Non-final Official Action dated August 7, 2001; an Amendment and Notice of Appeal filed October 10, 2002 in response to the Final Official Action dated April 10, 2002; a Request for Continued Examination filed November 11, 2002 in response to the Advisory Action of October 28, 2002; an Amendment filed June 2, 2003 in response to the Final Official Action dated February 4, 2003; an Amendment and Request for Continued Examination filed August 4, 2003 in response to the Advisory Action dated June 19, 2003; an Amendment filed December 22, 2003 in response to the Non-final Official Action dated September 24, 2003; an Amendment filed June 14, 2004 in response to the Final Official Action dated March 25, 2004; a Request for Continued Examination filed July 20, 2004 in response to the Advisory Action dated July 2, 2004; an Amendment filed December 7, 2004 in response to the Non-final Official Action dated September 7,

2004; a Notice of Appeal filed July 12, 2005 in response to the Non-final Official Action dated May 17, 2005; and an Appeal Brief dated January 4, 2006. A copy of the claims as they now stand is provided in Appendix A attached hereto.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) having a wall thickness from 1 to 3 mm. (See the Specification page 1, lines 20-23; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter also relates to a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and an average modulus of elasticity of less than 1MN/M^2 . (See the Specification page 1, lines 20-23; page 2, lines 1-5; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter further relates to a play set comprising a doll and a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) having either a wall thickness from 1 to 3 mm or an average modulus of elasticity of less than 1MN/M^2 . (See

the Specification page 1, lines 1-3; page 1, lines 20-23; page 2, lines 1-5; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter still further relates to a play set comprising, in cooperative combination, a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of the joints of the shoulders, elbows, knees, neck and hips, the garment has a through hole that accommodates passage of a doll's head or limb(s) and being molded from an elastomeric material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene rubber, styrene-butadiene triblock rubber, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer rubber, the garment having a wall thickness from 1 to 3 mm and an average modulus of elasticity of less than 1MN/M². (See the Specification page 1, lines 1-3; page 1, lines 20-23; page 2, lines 1-5; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; page 1 line 20 through page 2, line 3 and the Figures).

The claimed subject matter yet further relates to a doll's flexible and elastic garment which is adapted to be dressed, fitted and be removed from a doll in a life-like way, said garment comprises a flexible and elastic injection molded elastomeric copolymer material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer, the garment having a molded shape to fit over external surfaces of at least a portion of the doll that has articulated

limbs and a wall thickness from 1 to 3 mm, said garment having an average modulus of elasticity of less than 1MN/M², has a through hole that accommodates passage of a doll's head or limb(s). (See the Specification page 1, lines 20-23; page 2, lines 1-5; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; page 1 line 20 through page 2, line 3 and the Figures).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 20-23, 25-26 and 28-51 are rejected under 35 U.S.C. §112, second paragraph.

Claims 21-23, 25, 28 and 30-34 are rejected under 35 U.S.C. §103(a) over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036).

Claim 6 is rejected under 35 U.S.C. §103(a) over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) as applied to Claims 21-23, 25, 28 and 30-34 and further in view of Whitney (U.S. Patent No. 6,475,609).

Claims 20, 29 and 35-37 are rejected under 35 U.S.C. §103(a) over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) as applied to Claims 21-23, 25, 28 and 30-34 and further in view of Yasuda (U.S. Patent No. 5,928,803).

Claims 38-51, are rejected under 35 U.S.C. §103(a) over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339), Yasuda (U.S. Patent No. 5,928,803) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036).

ARGUMENT

Rejection of Claims 20-23, 25-26, and 28-51 under 35 U.S.C. §112, second paragraph

The rejection states “Claims 21-22, 38 and 47 are indefinite since all that the Appellants consider to be encompassed by the phrase “‘in a life-like way’ cannot be determined.”

The Appellants first note that this is a new rejection raised only after the Appellants have appealed these claims and after the issuance of six (6) Official Actions directed to these claims containing the language at issue. The Appellants respectfully submit that if the language at issue was truly indefinite, it would have been raised during at least one of the earlier six (6) Official Actions (when other §112 issues were raised). The Appellants therefore respectfully submit that the rejection is both baseless and untimely.

In any event, the language at issue, namely “in a life-like way,” is clear to those skilled in this art. This can be seen by placing the specific language at issue in the context of the rest of the claims in which it is used and by a simple reference to the Appellants’ Specification and drawings. In fact, the Appellants respectfully submit that the language at issue must be viewed in that context. Taken in context, the language at issue is recited in, for example, Claim 38 as a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of the joints of the shoulders, elbows, knees, neck and hips, the garment having a through hole that accommodates passage of a doll’s head or limbs and being molded from elastomeric material. What this plainly means to those skilled in the art is that the garments and playsets of the rejected claims are donned or “put on” to a doll in the same manner that a human being ordinarily dons or puts on a correspondingly similar piece of real clothing.

The Appellants specifically refer to this way of “dressing” the dolls in the paragraph spanning pages 3 and 4 of the Specification. That paragraph also refers the reader to Figs. 3A-3F. The Specification teaches those skilled in the art that due to their elasticity, the garments can be fitted in a life-like way, *i.e.*, jackets are donned “arms first” and dresses, trousers and skirts are stepped into. However, upper garments may more easily be donned over the feet due to the diameter of the doll’s head and the usual positioning of the arms. Once clothed, the doll’s limbs can still be moved. The garments are easily interchanged, even by younger children. One garment can be donned over another, e.g. a jacket over a dress.

What this means to those skilled in the art (and even those less skilled in the art) is that children can dress and undress dolls in the same manner that human beings dress and undress their ordinary clothes on a daily basis. The Appellants therefore respectfully submit that there is nothing indefinite about the “in a life-like way” language set forth in the rejected claims and that one skilled in the art can readily determine the meaning of that language simply by life’s ordinary experience lived on a day to day basis and, particularly so, when taken in the context of the language surrounding the language at issue in the claims and in the context of the Appellants’ Specification and drawings. The Appellants respectfully request reversal of the rejection.

Rejection of Claims 21-23, 25, 28 and 30-34 under 35 U.S.C. §103(a)

Claims 21-23, 25, 28 and 30-34 under 35 U.S.C. §103(a) over O’Brian in view of Kramer and either Gross or Wion.

The Appellants respectfully submit that this is another untimely rejection. Again, after many issued Official Actions utilizing this prior art, this new rejection has now switched the order of the primary reference with one of the three secondary references. The Appellants respectfully submit

that switching the order does nothing to cure the deficiencies of all of the cited prior art because such a switch does not provide new disclosure by that prior art upon which to base a new rejection. The new rejection should have been made years ago.

In any event, the rejection begins by stating that O'Brian discloses in Figs. 1-7 a garment comprising a flexible and elastic molded thermoplastic elastomer. The rejection cites Column 3, lines 54-56 and Column 4, line 58 for support. The rejection relies on a quotation of a dictionary definition of the word "resilient." The rejection admits that O'Brian does not disclose a doll having articulated limbs, dolls garments formed from a flexible sheet of polymeric plastic material between 2 MN and 6 MN in thickness and a modulus of elasticity of less 1 MN/M².

The Appellants decline to engage in a contest of dictionary comparisons, especially in view of the recent *Phillips*' Decision. Instead, the Appellants will rely on the ordinary meaning of the words in the rejected claims, the Appellants' Specification and in the O'Brian disclosure. In that regard, O'Brian discloses clothing as shown in Figs. 2 and 3 that is shaped to "snap" its hard plastic pieces onto a non-articulable doll such as a doll shown in Fig. 1. Such "snapping" action is a completely different mechanism to achieve positioning of clothing relative to the doll or a doll-like shape as compared to Kramer or as compared to the rejected claims.

The rejection relies on the notion of a single piece of resilient material that has a front and pair of sides and the front and sides are shaped so that at least a part of the article of apparel is curved to the rear of the article of apparel in a shape corresponding to the shape of a part of the doll and is adapted to resiliently engage the doll to hold the article of apparel in a predetermined position upon the doll. This is done when the article of apparel is "temporarily deformed" and "snapped" into the predetermined position on the doll. This is set forth in Column 4, beginning at line 58 as noted in the rejection and extending through to line 66.

However, the O'Brian approach is completely different from that of the rejected claims and Kramer. Also, the "resilient" material is completely different. The importance of the resilience is that the curved rear portions of the article of apparel can be "pried" apart sufficiently far enough to create a gap that is wide enough to fit around the doll and then upon release of the force used to enlarge the gap, "snap" back into the predetermined position. The Appellants respectfully submit that this is no way suggestive of an elastic material. Those skilled in the art know that elasticity refers to stretchability. This is in no way to be confused with the concept of a resilient material.

In any event, "snapping" an article on to a doll is not donning that article "in a life-like way" as claimed by the Appellants. "Snapping" is also not suggestive of "a life-like way." O'Brian therefore leads those skilled in the art away from the subject matter of the rejected claims.

Additionally, O'Brian fails to disclose, teach or suggest injection molded thermoplastic elastomer. The Official Action of March 28, 2006 points to Column 3, lines 54-56 of O'Brian, which is reproduced below in its entirety.

Preferably in manufacturing the doll 10 and the various articles of apparel illustrated, as well as the base utilized with this doll 10, a flat sheet 34 of any number of a number of thermoplastic materials, such as, for example, polyethylene, polystyrene or the like, is printed or otherwise similarly colored substantially as indicated in Fig. 6 of the drawings in various colors and shapes, etc. so that different portions of the sheet 34 correspond to the doll 10 and the various articles of apparel it is desired to utilize with this doll.

This portion of O'Brian is not applicable because it does not anywhere mention the word "elastomer." As a result, O'Brian does not support the disclosure of an elastomer. In fact, the Appellants have carefully scrutinized the entire text of O'Brian and the word "elastomer" never appears at any location. The clothing of O'Brian is rigid yet resilient (or semi-rigid under a liberal interpretation) and snapped on, which is critical because the snap-on clothing of O'Brian is just the type of clothing that the Appellants seek to avoid. The fact that O'Brian discloses a thermoplastic

material in no way means that it discloses, teaches or suggests an elastomer. Those skilled in the art know that thermoplastic materials are soft when warm and hard when cool. However, that in no way makes them elastic. Elasticity is a completely different concept and physical phenomenon than plasticity. The term “plastic” merely refers to the ability to be molded whereas the term “elastic” refers to being easily stretched and then resuming the former shape. Thus, O’Brian fails to either explicitly or implicitly disclose, teach or suggest “injection”, “elastomer” or “injection molded elastomer” which terms are explicitly recited in the Claims 21-23, 25, 28 and 30-34. Therefore, O’Brian fails to disclose, teach or suggest an injection molded thermoplastic elastomer. As a consequence, O’Brian is non-enabling.

In sharp contrast to O’Brian and the rejected claims, Kramer discloses a sheet system, wherein sheets of material having selected characteristics may be formed into essentially a planar doll shape, *i.e.*, essentially two-dimensional, among other planar shapes. The characteristics of the sheet are selected so that, when wetted, the sheet sticks to a hard surface such as a ceramic surface. This results from surface tension between the sheet and the hard surface as created by an intervening layer of water, as is shown in Fig. 3 of Kramer.

Additionally, another layer of similar planar sheet material, cut into the form of clothes, is first wetted and then laid over the doll shaped sheet. Thus, a child can form a type of doll on the tiles adjacent a bathtub and vary the clothing associated with that doll. Surface tension and the intervening water layer between the doll-shaped sheet and the clothes sheets allows that system of Kramer to function in its intended manner.

In sharp contrast to Kramer, Claims 21-23, 25, 28 and 30-34 relate to dolls and play sets including such dolls that are not characterized as planar, but are known in the ordinary three-dimensional sense and involve doll’s garments which also have a three-dimensional shape. The

garments are molded in particular shapes such that they will fit over the varied three-dimensional surfaces of portions of the doll in a life-like way. The garments and play sets of Claims 21-23, 25, 28 and 30-34 do not rely on the presence of water created surface tension to achieve the fit on the doll.

O'Brian discloses conventional doll structures and, as a consequence, one of ordinary skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer. Kramer is directed to "clothing" items that are essentially two dimensional, i.e. planar, and "dolls" that are not articulable. The clothing disclosed by O'Brian, such as that shown in Figs. 2 and 3, is shaped to "snap" its hard plastic pieces onto the non-articulable doll, as shown in Fig. 1. Such "snapping" action is a totally different mechanism to achieve positioning of the clothing relative to the doll or a doll-like shape as compared to Kramer, which relies on surface tension supplied by the presence of water.

Both of those technologies are different from each other and very different from the subject matter of Claims 21-23, 25, 28 and 30-34. The flexible and elastic injection molded thermoplastic elastomer doll's garments of Claims 21-23, 25, 28 and 30-34 are sized and shaped to fit over dolls in a life-like way, such that they are adaptable to articulable dolls. In other words, the doll's garments are donned in the same fashion that real people don or put on their clothes. For example, jackets are donned "arms first" and dresses, trousers and skirts are "stepped into." The fact that the dolls have articulated limbs and the garments are flexible and elastic and fitted in a life-like way over the doll, is neither taught nor suggested by either Kramer or O'Brian. Thus, dolls' garments adapted for either or both of Kramer or O'Brian are not adaptable to articulable dolls as is the case of the garments of Claims 21-23, 25, 28 and 30-34. Thus, one of ordinary skill in the art, when attempting to design garments for articulable dolls or for dolls having articulated limbs, would have no incentive to use the

teachings of either Kramer or O'Brian. As a consequence, one of ordinary skill in the art would have no incentive to make the hypothetical combination.

In particular, the Appellants respectfully submit that one skilled in the art would not make the hypothetical combination of a flat sheet of material from Kramer that is designed to adhere to another flat sheet of material by water induced surface tension with a hard yet resilient material of O'Brian that is intended to "snap on" a three dimensional doll. At best, the teachings of Kramer are such that the flat sheet of flexible polymer plastic would be adhered to the doll figure of O'Brian by water induced surface tension. In other words, one skilled in the art would take the flat sheet material of Kramer, place it or the doll of O'Brian into water and then wrap the flat sheet of material around the doll.

One skilled in the art would readily see the pitfalls of such an attempt. There would be almost no way to effectively do this in a doll that is life-like and has articulatable joints. Wrapping the Kramer sheet material would be virtually impossible in the first place and would surely be displaced upon any articulation of the various joints of the doll (which are neither taught nor suggested by either reference).

In any event, even if one skilled in the art were to make that hypothetical combination, the resulting structure would still be something completely different from that set forth in the rejected claims. For example, Claim 38 recites a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of joints of the shoulders, elbows, knees, neck and hips, the garment having a through hole accommodates passage of the doll's head or limbs and being molded from an elastomeric material. The combination of Kramer with O'Brian fails to teach or suggest this. It stretches one's imagination

to consider that wrapping a flat sheet to be adhered to the surface of a doll through water induced surface tension as being “life-like” in any way. As a consequence, the Appellants respectfully submit that one skilled in the art would not make the hypothetical combination as set forth in the rejection.

One of ordinary skill in the art would have no incentive to make the hypothetical combination of O’Brian with Kramer as mentioned above and further in view of Gross. Gross fails to disclose, teach or suggest the cure for the deficiencies set forth above with respect to Kramer and O’Brian. There is no discussion of injection molding. Moreover, Gross uses a rigid core covered with an elastic skin that is not at all removable, but is partially adhered to the rigid core to facilitate selected areas where the skin may expand relative to the core to simulate changes in muscle tone or weight gain.

Gross is directed to a doll or toy figure that uses what is essentially a series of bladders that are able to expand and contract to portray weight gain or loss, muscle building, or the like. While Gross discloses a doll with articulated limbs, the bladder portions of Gross do not extend over the articulatable areas. Instead, the bladders are restricted to particular areas that do not include articulated portions. In sharp contrast, Claims 21-23, 25, 28 and 30-34 recite garments meant to be removed from an articulatable doll. As a consequence, even if one of ordinary skill in the art were to make the hypothetical combination of both of Gross and Kramer with O’Brian, the resulting structure would still not result in, teach or suggest the injection molded thermoplastic elastomer doll’s garment of Claims 21-23, 25, 28 and 30-34.

Hypothetically combining Wion would not cure the deficiencies of Kramer, O’Brian, and Gross as noted above. Thus, even if one skilled in the art combined them with Wion, the result would be structure that is far afield of the subject matter of Claims 21-23, 25, 28 and 30-34. Reversal of the rejection of Claims 21-23, 25, 28 and 30-34 is respectfully requested.

Rejection of Claim 26 under 35 U.S.C. §103(a)

Claim 26 is rejected under 35 U.S.C. §103(a) over the hypothetical combination of O'Brian in view of Kramer and either Gross or Wion as applied to Claims 21-23, 25, 28 and 30-34 and further in view of Whitney.

The Appellants have already established that one skilled in the art would not make the hypothetical combination of Kramer, Gross or Wion with O'Brian and, in any event, even if the hypothetical combination were to be made, that the resulting structure would still fail to teach or suggest the subject matter of Claims 21-23, 25, 28 and 30-34. The Appellants respectfully submit that further hypothetically combining Whitney would still fail to cure the deficiencies set forth above. Whitney provides no additional disclosure, teachings or suggestions that would cause one skilled in the art to make the hypothetical combination. Also, Whitney fails to disclose, teach or suggest additional subject matter that would result in a garment or a playset that includes a doll donned and fitted with a flexible and elastic injection molded garment which is molded to the removed, dressed and refitted again over external surfaces of the doll in a life-like way. Reversal of the rejection of Claim 26 is respectfully requested.

Rejection of Claims 20, 29 and 35-37 under 35 U.S.C. §103(a)

Claims 20, 29 and 35-37 are rejected under 35 U.S.C. §103(a) over the hypothetical combination of O'Brian in view of Kramer and either Gross or Wion as applied to Claims 21-23, 25, 28 and 30-34 and further in view of Yasuda.

The Official Action of March 28, 2006 states that the “Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.” The Appellants respectfully disagree. A modified device of Kramer fails to disclose, teach or suggest much more.

Those deficiencies of O'Brian, Kramer, Gross and Wion have been clearly set forth above with respect to the earlier rejection and need not be repeated here. However, they apply with the same effectiveness.

Even if one of ordinary skill in the art were to use the various materials disclosed by Yasuda as they apply to the specifics of Claims 20 and 29 and 35-37, the result would still be structures far different from those recited in Claims 20, 29 and 35-37. For example, applying the materials of Yasuda to the "clothes" of Kramer would result in flat, planar garments designed to adhere to the flat, planar doll shaped cutouts disclosed by Kramer.

Similarly, if one of ordinary skill in the art were to use the materials of Yasuda for O'Brian, the result would be garments of the "snap-on" type having nothing to do with the garments of Claims 20, 29 and 35-37. In fact, one of ordinary skill in the art might very well hesitate to substitute the materials of Yasuda for the specific materials disclosed by O'Brian because substitution of such materials might destroy the "snap-on" ability of those garments as contemplated by O'Brian. Thus, hypothetically combining Yasuda with O'Brian and Kramer would still fail to teach or suggest flexible and elastic garments adapted to be fitted, dressed and removed from a garment in a life-like way when the doll has articulated limbs.

Even if combined, O'Brian in view of Kramer and either Gross or Wion and Yasuda, would fail to teach or suggest the subject matter as recited in Claims 20, 29 and 35-37. This rejection selects isolated bits and pieces of the claimed subject matter from at least four separate disclosures and combines them together with utterly no teachings or suggestions to do so. In order to hypothetically combine references, it is required that there be teachings or suggestions to 1) make modifications and 2) a reasonable chance of success that such modifications would be successful. Neither prong is satisfied here. As previously noted, there are no teachings or suggestions to

combine Kramer with O'Brian inasmuch as O'Brian employs snap-on garments whereas Kramer employs surface tension caused by the presence of water. Yasuda is non-enabling with respect to what kind of doll is contemplated. This is also sharply contrasted to Gross which employs dolls that have articulations, but uses bladders that do not cover the articulations. Thus, one of ordinary skill in the art would find neither teachings nor suggestions to either make the hypothetical combinations in the first place or give rise to a reasonable expectation of success upon making such combinations. Reversal of the rejection is respectfully requested.

Rejection of Claims 38-51 under 35 U.S.C. §103(a)

Claims 38-51 are rejected under 35 U.S.C. §103(a) over O'Brian in view of Kramer, Yasuda and either Gross or Wion. The Appellants have already demonstrated why one skilled in the art would not combine O'Brian in view of Kramer in view of Yasuda and either Gross or Wion presented above. This alone substantiates reversal of the rejection.

The Appellants respectfully submit that O'Brian does not disclose "most of the elements of these claims" as set forth in that rejection. However, the Appellants fully agree that Kramer does not disclose an injection-molded thermoplastic elastomer doll's garment and a doll having articulated limbs. Also, the Appellants agree that Kramer does not disclose a finish selected from the group consisting of paint, varnish and glitter, the garment is 8 cm in height or a playset including a doll, wherein the doll is articulated in a joint selected from the group consisting of shoulders, elbows, knees, neck and hips.

The Appellants do not agree that O'Brian teaches the concept of providing elastic injection molded thermoplastic elastomer doll's garments. The Appellants have carefully examined every word of the O'Brian text and do not see the word "injection" in any location of that disclosure.

Accordingly, O'Brian inherently fails to disclose, teach or suggest injection molded thermoplastic elastomer. Therefore, hypothetically combining Kramer with O'Brian still fails to disclose, teach or suggest an injection molded thermoplastic elastomer.

The same applies to “elastomer.” The rejection refers to column 3 at lines 54-56 to support the notion that O'Brian discloses an injection molded thermoplastic elastomer. Unfortunately, that text does not support the disclosure of an elastomer. The fact that that text discloses a thermoplastic material in no way means that it discloses, teaches or suggests an elastomer. Thermoplastic materials are soft when warm and hard when cool by definition. However, that in no way makes them elastic. Elasticity is a completely different concept and physical phenomenon than plasticity or resilience. Resilient merely refers to the ability to be molded and resuming its shape when subjected to stress whereas elastic refers to the ability to be easily stretched and then resuming the former shape. The fact that Kramer mentions a modulus of elasticity of less than 750 psi means to those of ordinary skill in the art that the Kramer pieces are flexible, not elastic or stretchable. The Appellants accordingly respectfully submit that O'Brian fails to either explicitly or implicitly disclose, teach or suggest “injection” and “elastomer,” both of which terms are explicitly recited in the Claims 38-51. Therefore, even if one of ordinary skill in the art hypothetically combines Kramer with O'Brian, there is still no disclosure, teaching or suggestion of an injection molded thermoplastic elastomer. Thus, reliance on the word “resilient” is erroneous.

Moreover, one of ordinary skill in the art would not make the hypothetical combination of Kramer with O'Brian in the first place. Kramer is directed to clothing items that are essentially two dimensional, i.e. planar, while O'Brian is directed to “snap-on” clothing items. These have nothing to do with one another and operate under completely different theories of how to place clothes into a selected, desired position with respect to a doll or doll like shape. Kramer relies of the surface

tension created by the presence of water, while O'Brian relies on the "snap-on" feature. These are completely different approaches that would not cause one of ordinary skill in the art to make the hypothetical combination.

In any event, both approaches are unlike that recited in Claims 38-51 and are nothing like the approach taken by the Appellants. The Appellants' injection molded thermoplastic elastomer doll's garments are sized and shaped to fit over dolls in a life-like way. In other words, the doll's garments of the invention are donned in the same fashion that real people don their clothes. For example, jackets are donned "arms first" and dresses, trousers and skirts are "stepped into." This is not the case with Kramer which relies on surface tension supplied by the presence of water and is not the case in O'Brian which "snaps on" its hard plastic pieces. As a consequence, one of ordinary skill in the art would have no incentive to make the hypothetical combination. In any event, both references fail to disclose, teach or suggest the claimed flexible and elastic injection molded material sized and shaped to be donned in a life-like way. There is simply no such disclosure in either reference.

Further hypothetically combining Gross or Wion with the primary and other secondary reference fails to cure the fatal deficiencies already described. Yasuda fails to provide teachings or suggestions that satisfy the deficiencies of the original combination of Kramer with O'Brian. Unlike O'Brian, Yasuda mentions injection molding. Such mention may be found at Column 5 in the paragraph beginning at line 40. However, injection molding is not mentioned in a context that is applicable in the hypothetical combination. Specifically, Yasuda refers to injection molded resin layers such as the layers 2A, 3 and 2B as shown in Figs. 1 – 9. Those injection molded layers/articles are then laminated with other films to form a resulting resin molded article. However, that is not what the Appellants do and not what the Appellants claim. The Appellants' garments are actually injection molded thermoplastic elastomer. Moreover, one of ordinary skill in the art would have no

comprehension as to whether the laminate (not the layers) is elastic as claimed. It would be nothing more than speculation to say that Yasuda laminates are elastic (as opposed to just being bendable).

The Appellants respectfully submit that hypothetically combining Yasuda with either or both of O'Brian and Kramer still fails to teach or suggest the subject matter recited in Claims 38 - 51. The disclosure of Yasuda is nonenabling with respect to whether the laminates would have any application to dolls having articulated limbs. There is no disclosure on this point. The Yasuda disclosure is limited to a very brief reference to the fact that the laminates can have fabric bonded to the outmost resin layer to have a soft texture and a unique appearance effective, for example, "clothing for dolls" or other decorative elements. (Column 8, first full paragraph.) There is no mention of the type of dolls and whether they have articulated limbs. Thus, one of ordinary skill in the art would have no incentive to make the hypothetical combination with O'Brian which relates to dolls that do not have articulated limbs or to Kramer which also refers to planar shaped doll cutouts that do not have articulated limbs. Therefore, one of ordinary skill in the art would have no incentive to make the hypothetical combination.

In any event, even if one of ordinary skill in the art were to use the various materials disclosed by Yasuda as they apply to the specifics of Claims 38 - 51, the result would still be structures far different from those recited in Claims 38 - 51. For Example, applying the materials of Yasuda to the "clothes" of Kramer would still result in flat, planar doll's garments designed to adhere to flat, planar doll shaped cutouts disclosed by Kramer. Again, this has nothing to do with the invention as recited in Claims 38 - 51.

Similarly, even if one of ordinary skill in the art were to use the materials of Yasuda for O'Brian, the result would still be garments of the "snap-on" type that have nothing to do with the garments of Claims 38 - 51. In fact, one of ordinary skill in the art might very well likely hesitate to

substitute the materials of Yasuda for the specific materials disclosed by O'Brian because substitution of such materials might destroy the "snap-on" ability of those garments as contemplated by O'Brian.

In any event, hypothetically combining Yasuda with O'Brian and Kramer would still fail to teach or suggest flexible and elastic garments adapted to be fitted, dressed and removed from a garment in a life-like way when the doll has articulated limbs. Renewal of the rejection of Claims 38-51 based on Yasuda, O'Brian and Kramer is respectfully requested.

Additional Arguments

The Appellants were the first to invent the subject matter of Claims 20-23, 25, 26 and 28-51 and have licensed that subject matter to a well known toy manufacturer and enjoyed great commercial success, which is indicium of nonobviousness. Since the subject matter was licensed, this invention has revolutionized fashion play in small dolls and the licensee will have sold over \$440,000,000 worth of product around the world and over \$220,000,000 in the U.S. in five years by the end 2003. A chart of sales through 2004 is as follows:

<u>Year</u>	<u>Worldwide</u>	<u>USA</u>
1999	8	7.5
2000	30	15
2001	78	38
2002	127	62
2003	200	100
2004	172	95
Total	615	317.5

The above figures do not include sales of boy's figures to licensees other than the one mentioned above. To obtain the retail value of the above sales, it would be necessary to double or triple those figures (which are licensee's sales value). In other words, sales of product with molded elastic clothes that are the subject of the solicited claims have exceeded \$1 billion in five years at retail value worldwide.

Also, the product, sold under the name "Fashion Polly" (under the Polly Pocket brand), was awarded the coveted Toy of the Year by Mattel (the world's largest toy company). The product has single-handedly rescued a brand name (Polly Pocket) from the verge of extinction in 1999 and turned it around to be the best selling small doll in the world.

The undeniable commercial success of the product that is the subject of the license is because of the subject matter of Claims 20-23, 25, 26 and 28-51 and not due to inordinate quantities of advertising. In fact, the amount of advertising spent on the product is below the "spend to sales ratio" of competitive toys. Also, unlike many of its peer products in boy's and girl's toys, it has not been the subject of any cartoon or other entertainment support along with the usual merchandising campaigns (e.g., like a Disney property, or Barbie). In spite of below average expenditure of funds in marketing the product, it has been a resounding success and has spawned many attempts by others to enjoy the financial rewards provided the Appellants' advance in this art. There is no clearer proof of the non-obviousness of this product as set forth by the commercial success described above and the overt copying by others. A copy of a Declaration of one of the inventors that is already on the record is attached as Appendix B.

The Appellants also note that a wide variety of hypothetical combinations of different prior art disclosures have been hypothetically combined to reject the Claims 20-23, 25, 26 and 28-51. However, those hypothetical combinations have either not been appropriate or, even if made, still fail

to teach or suggest the invention of Claims 20-23, 25-26 and 28-51. Also, they rely on the notoriously tempting concept known as "hindsight." This technology is not especially complicated and is, therefore, susceptible to its use. However, hindsight is strictly forbidden, irrespective of the relative complexity of Claims 20-23, 25, 26 and 28-51.

The Court of Appeals for the Federal Circuit has decisively confirmed this point in its recent decision *In re Fritch*, 23 U.S.P.Q. 2d, 1780 (Fed. Cir. 1992). The CAFC has clearly prohibited hindsight:

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." 23 U.S.P.Q. 2d at 1783-1784.

The foregoing discussion is binding with respect to this application. It is impermissible to pick and choose portions of a disclosure and use hindsight reconstruction to reject the Claims 20-23, 25, 26 and 28-51.

The Appellants respectfully request that the rejection of Claims 20-23, 25, 26 and 28-51 accordingly be reversed as to all claims.

Respectfully submitted,


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APPENDIX A

Listing of Claims

Claims 1 – 19 (Cancelled)

20. (Previously Presented) The garment of claim 21 wherein said thermoplastic elastomer is selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, and butadiene-styrene copolymer.

21. (Previously Presented) A garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and a wall thickness from 1 to 3 mm.

22. (Previously Presented) A garment comprising a flexible and elastic injection molded thermoplastic elastomer doll 's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and an average modulus of elasticity of less than 1 MN/M2.

23. (Previously Presented) The garment of claim 21, wherein said garment includes an integrally molded detail selected from the group consisting of a belt, a button, a ribbon, a bow, a cuff, a pocket, a lapel, and a collar.

24. (Cancelled)

25. (Previously Presented) The garment of claim 21, wherein said garment simulates clothing selected from the group consisting of a dress, a pair of dungarees, a jacket, a skirt, a vest, a pair of slacks, a hat, a coat, and a gown.

26. (Previously Presented) The garment of claim 21, further including a finish selected from the group consisting of paint, varnish, and glitter.

27. (Cancelled)

28. (Previously Presented) The garment of claim 21 wherein said garment is less than 8 cm in height.

29. (Previously Presented) The garment of claim 20 wherein said garment includes an integrally molded detail and said garment simulates clothing.

30. (Previously Presented) The garment of claim 21, wherein said garment has an average modulus of elasticity of less than 1 MN/m².

31. (Previously Presented) The garment of claim 21, wherein the 100% modulus of elasticity is between 240 and 280 KN/m².

32. (Previously Presented) The garment of claim 21, wherein the 300% modulus of elasticity is between 440 and 490 KN/m².

33. (Previously Presented) A play set comprising a doll and a garment according to claim 21.

34. (Previously Presented) The play set of claim 33 wherein said doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips.

35. (Previously Presented) The play set of claim 34 wherein said thermoplastic elastomer is selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, and butadiene-styrene copolymer.

36. (Previously Presented) The play set of claim 35 wherein said garment includes an integrally molded detail.

37. (Previously Presented) The play set of claim 35 wherein said garment simulates clothing.

38. (Previously Presented) A play set comprising, in cooperative combination, a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of the joints of the shoulders, elbows, knees, neck and hips, the garment has a through hole that accommodates passage of a doll's head or limb(s) and being molded from an elastomeric material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene rubber, styrene-butadiene triblock rubber, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer rubber, the garment having a wall thickness from 1 to 3 mm and an average modulus of elasticity of less than 1 MN/m².

39. (Previously Presented) The play set of claim 38, wherein the garment includes at least one integrally molded detail.

40. (Previously Presented) The play set of claim 39, wherein said detail is selected from the group consisting of: a belt, a button, and a collar for the garment.

41. (Previously Presented) The set of claim 38, wherein said garment has a 100% modulus of elasticity between 120 and 350 KN/m².

42. (Previously Presented) The set of claim 39, wherein said garment has a 100% modulus of elasticity between 240 and 280 KN/m².

43. (Previously Presented) The set of claim 38, wherein said garment has a 300% modulus of elasticity between 440 and 490 KN/m².

44. (Previously Presented) The set of claim 38, which comprises a plurality of seamless garments each being adapted to be removed and refitted to the doll.

45. (Previously Presented) The set of claim 38, wherein the garment is a dress, a pair of dungarees, a jacket, a skirt, a vest, a pair of slacks, a hat or a coat.

46. (Previously Presented) The set of claim 38, wherein the material of the garment has a decorative coating of paint or varnish.

47. (Previously Presented) A doll's flexible and elastic garment which is adapted to be dressed, fitted and be removed from a doll in a life-like way, said garment comprises a flexible and elastic injection molded elastomeric copolymer material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer, the garment having a molded shape to fit over external surfaces of at least a portion of the doll that has articulated limbs and a wall thickness from 1 to 3 mm, said garment having an average modulus of elasticity of less than 1 MN/m², has a through hole that accommodates passage of a doll's head or limb(s).

48. (Previously Presented) The doll's garment of claim 47 further including at least one integrally molded detail.

49. (Previously Presented) The garment of claim 48 wherein said detail is selected from the group consisting of: a belt, a button, and a collar for the garment.

50. (Previously Presented) The doll's garment of claim 49 wherein said garment has a 100% modulus of elasticity between 120 and 350 KN/M².

51. (Previously Presented) The doll's garment of claim 50 wherein said garment has a 100% modulus of elasticity between 240 and 280 KN/M².



APPENDIX B

Copy of Declaration of Mr. Casey William Norman



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	:	3712	Customer No.:	035811
Examiner	:	Faye Francis		
Serial No.	:	09/844,322		
Filed	:	April 26, 2001		
Inventors	:	Casey William Norman	Docket No.:	1391-CON-00
	:	Torquil Patrick Alexander Norman	Confirmation No.:	1969
Title	:	DOLL'S CLOTHING		

Declaration of Mr. Casey William Norman

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Casey William Norman, declare that I reside at Thornhill, Withington Road, Andoversford, Gloucestershire GL54 4LL, United Kingdom. I worked for the UK company Bluebird Toys plc for seven years, the last four of those as Development Director. Subsequently I founded the company Genie Toys plc in 1996, in which I currently serve as its Managing Director.

I am a co-inventor of the above-identified Application. I am familiar with the Official Action dated September 24, 2003 and have thoroughly studied the prior art used to reject the claims in the Application. As a result of my long experience in the toy industry, I can unequivocally state that the prior art utilized to reject the claims in the Application does not render those claims obvious. Rejection of the claims is based on the use of hindsight, not actual teachings or suggestions gleaned from the prior art.

The subject matter of the claims in this Application has been commercialized. That commercialization has been a resounding success beyond my expectations. That commercial success resulted from the inventive features of this invention and not from advertising or promotional efforts beyond standard efforts consistent with industry norms. In other words, products that have been commercialized based on the subject matter claimed in this Application have enjoyed commercial

success far beyond what could reasonably be expected compared to other toy products with the same investment in advertising and promotional dollars.

The subject matter that is claimed in this Application has been licensed to a well known toy manufacturer. That subject matter has revolutionized fashion play in small dolls. As a result, the licensee has sold over \$440,000,000 of product around the world and over \$220,000,000 in the United States within the last five years (calculated through the end of this year). A Table indicating the sales for years 1999 through 2003 is set forth below.

<u>Year</u>	<u>Worldwide</u>	<u>USA</u>
1999	8	7.5
2000	30	15
2001	78	38
2002	127	62
2003	200	100
Total	443	222.5

It is important to note that the sales figures set forth above do not include sales of boys' doll figures to licensees other than the licensee mentioned above. Also, to obtain the retail value of the above sales figures, it would be necessary to increase substantially the numbers in the Table. (Those numbers would be the licensee's reported sales value.) Thus, sales of product within the scope of the claims of this Application may have exceeded one billion dollars in five years at retail value worldwide.

The product mentioned above has been sold under the name "Fashion Polly" (under the Polly Pocket brand). This product was awarded the "Girl's Inventor Product of the Year" by Mattel, which

is the world's largest toy company. This is an important award in the industry and is highly sought after. The features of the product, the way in which it has transformed the small dolls segment of the industry and the rapid increase in sales indicate the importance of the advance this invention has brought about. In fact, this single product innovation has rescued a brand name (Polly Pocket) from the verge of extinction in 1999. Polly Pocket is now the bestselling small doll in the world as a consequence of the molded elastic clothes product that is the subject matter of the claims of this Application.

As I noted above, the amount of advertising and promotional efforts spent on the product is actually below the "spend-to-sales ratio" of competitive toys. Further, it is different from many peer products in girls and boys' toys because it has not been the subject of any cartoon or other entertainment support or typical merchandising campaigns (for example, such as are typical of Disney properties).

Finally, one of the best indicators of the advance made by this product is the fact that the product is now being copied by other toy manufacturers in an effort to share in the financial success brought about by this product.

The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and thus such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 16th December 2003



Casey William Norman, co-inventor



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 3725	Customer No.: 035811
Examiner	: Faye Francis	
Serial No.	: 09/844,322	
Filed	: April 26, 2001	Docket No.: 1391-CON-00
Inventors	: Casey William Norman	
	: Torquil Patrick Alexander Norman	Confirmation No.: 1969
Title	: DOLL'S CLOTHING	

Dated: June 26, 2006

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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Postcard
Appeal Brief
Appendix A (Listing of Claims)
Appendix B (Copy of Declaration of Mr. Casey William Norman)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to **Mail Stop Appeal Brief - Patents**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date appearing below.

Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

DLA Piper Rudnick Gray Cary US LLP

Customer No. 035811

By: Julie Hood

Date: June 26, 2006